

REMARKS

With the entry of the foregoing amendments, claims 1-13 are pending in this application. Favorable consideration is requested.

Claim 1 has been amended to place it more in line with typical US formatting. New claim 13 has been added, as supported by the specification, e.g., page 3, line 14. No new matter has been added.

At the outset, applicant thanks the Examiner for withdrawing all of the previous objections and rejections. In response to the new objections and rejections, applicant provides the following comments that render moot or overcome the new objections and rejections.

In response to the drawing objection on page 2 of the Office Action, and in line with USPTO practice, the specification has been amended to delete the reference number 23 because the calibrating apparatus is shown in total in Figure 8, as explained in the specification on page 7, line 16 and page 10, lines 4-5. No reference number 23 is required in the specification or drawings because Figure 8 is appropriately described in the specification as depicting the calibrating apparatus. Applicant submits that the specification amendment and foregoing information render the objection moot.

The following is a summary of the new prior art rejections:

1. Near the top of page 3 of the Detailed Action, claims 1, 2 and 4 stand rejected as allegedly being anticipated by Dale (USP 4,893,619). The Examiner contends that Dale discloses each and every claim feature set forth in claims 1, 2 and 4.
2. In the middle of page 3 of the Detailed Action, claims 1, 9, 11 and 12 stand rejected as allegedly being anticipated by Farmer (USP 5,141,512). The Examiner contends that Farmer discloses each and every feature set forth in claims 1, 9, 11 and 12.

3. At the bottom of page 3 and continuing to the top of page 4 of the Detailed Action, claims 1, 3, 7 and 8 stand rejected as allegedly being anticipated by Subba Rao (USP 6,743,235). The Examiner contends that this reference discloses each and every feature set forth in 1, 3, 7 and 8.
4. At the bottom of page 4 and continuing to the top of page 5 of the Detailed Action, claims 5 and 6 stand rejected as allegedly being obvious over Subba Rao in view of Sterrenberg (USP 4,393,599). The Examiner contends that it would have been obvious to one skilled in the art to re-construct the device of Rao in view of the disclosures in Sterrenberg.
5. In the middle of page 5, claims 1 and 10 stand rejected as allegedly being obvious over Buechel (USP 5030221) in view of Rao. The Examiner contends that it would have been obvious to one skilled in the art to re-construct the device of Buechel in view of the disclosures in Rao.

Applicant respectfully traverses these prior art rejections for at least the following reasons. In response to the prior art rejections, the following facts address all of the prior art rejections in joint fashion because the same facts are applicable to all of the rejections.

As amended, claim 1 is limited to a guide for an acetabular prosthetic cup instrument. Moreover, claim 1 and all other claims require that the particular guide comprise an **orientation means, distinct from the shaft, which are adapted to define a reference plane**. As mentioned in the specification, the applicant's orientation means are of the dual-axis type. See new claim 13. They therefore allow the definition of a reference plane. In fact, basic geometry shows that applicant's device requires at least two axes (or one axis and one point) in order to define a unique reference plane. In contrast, if there is only one axis, then no unique reference plane can be defined but, instead, an infinite number exist and no reference plane is defined.

In the claimed invention, the orientation means may consist of a special type of spirit level, e.g., forming a disc with a central circle in which the air bubble has to be maintained.

In contrast, if the spirit level has a cylindrical shape and if the air bubble has to be maintained between two lines in the cylinder, then the orientation means are of a single axis type and, consequently, do not allow the definition of a reference plane.

At this stage, it must be stressed that the use of the claimed orientation means in the claimed combination considerably improves the positioning of the acetabular cup in a patient. No prior art discloses, suggests or appreciates this combination and these features.

It must also be noted that the claimed invention with its unique orientation means, in view of the specification, should be understood as providing for detecting means which allow the surgeon to correctly orientate the instrument. But, taken as such, they are not able to simply fix the instrument along a defined direction. Stated another way, the claimed orientation means are measuring a parameter, in general gravity, which then helps the surgeon to correctly position his instrument. These facts are important to understand because they clearly assist with a better comprehension of the differences with the prior art.

Turning now to the prior art, the Dale reference does not disclose an orientation means as defined in the claims. The Office Action considers the Dale element 130 as an orientation means. However, a proper reading of the Dale reference confirms that this element is simply a knob which allows a person to fix some parts of the instrument.

Thus, Dale does not anticipate the claimed invention because it does not disclose the claimed orientation means.

The same considerations apply to the Farmer reference where the alleged orientation means may not be viewed as detecting and/or measuring means. The Farmer reference 73 cited in the Office Action only allows a person to fix some parts of the instrument, in the same manner as the Dale reference. Thus, Farmer does not anticipate the claimed invention because it does not disclose the claimed orientation means.

Finally, the Rao reference teaches and is limited to the use of a single axis type orientation. Thus, it does not anticipate the claimed invention. In fact, it teaches away from the use of any dual-axis type orientation and, therefore, would not be combined with any other reference (e.g., Sterrenberg or Buechel) in any "reasonably apparent" fashion (as required by the Supreme Court) to arrive at the claimed invention -- without running counter to the single axis teachings of Rao.

For at least the foregoing reasons, applicant requests the withdrawal of the prior art rejections.

In view of the foregoing amendments and remarks, applicant submits that this application is in condition for allowance. A notice to that effect is earnestly solicited.

If the Examiner has any questions concerning this application, the undersigned may be contacted at 703-816-4009. If any small matters remain in this case, the Examiner is encouraged to telephone the undersigned so that a further Office Action can be avoided.

ECHEVERRI
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Respectfully submitted,

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